

-- REMARKS --

Claims 14-33 are pending. By this amendment, claims 15, 17 and 18 have been amended, claims 21-33 have been added as new, and claims 1-13 have been canceled without prejudice. Support for these amendments is found, for example, in Figures 45-46 and at paragraphs [0200] through [0207] of the specification. Amendments to claims 15, 17 and 18 and cancellation of claims 1-13 are not to avoid any reference, but are intended to expedite prosecution of the remaining claims. Applicants respectfully request reconsideration and allowance of claims 14-33.

ELECTION/RESTRICTION

In the Office Action of May 19, 2010, the Examiner acknowledged applicants' election of Group III, claims 14-20. Applicants hereby affirm the election of Group III, represented by original claims 14-20. By this amendment, claims 1-13 have been canceled without prejudice. Applicants respectfully submit that newly added claims 21-33 are directed to the same invention of elected Group III.

INTERVIEW SUMMARY

Applicants acknowledge the Examiner's interview summary. On May 17, 2010, Frank Nicholas spoke with Examiner Duran, requesting withdrawal of finality of the Final Action dated February 22, 2010. Examiner agreed to vacate the Final Action dated February 22, 2010 and resend as a Non-Final Action.

CLAIM REJECTIONS – 35 USC 101

In the Office Action of May 19, 2010, the Examiner rejected claim 14 and its dependents under 35 U.S.C. 101 as being directed to non-statutory subject matter.

This rejection is respectfully traversed. Examiner has applied the so-called machine-or-transformation test for subject matter eligibility. In accordance with the July 27, 2010 Memorandum to the Examining Corps and the Federal Register Notice of the same date, the machine-or-transformation test is not the sole test for subject matter eligibility of method/process

claims. Applicants respectfully submit that the subject matter of claim 14 (and its dependents) is directed to more than just a general concept, abstract idea or law of nature, whereby the steps of the claimed method are observable and verifiable. Furthermore, the claimed method both expressly recites a machine (i.e. “receiving a request to advertise via the link at an ad server” [*emphasis added*]) and inherently requires machines for successful execution. Thus, applicants respectfully submit that the claims are directed to statutory subject matter.

PRIORITY

In the Office Action of May 19, 2010, the Examiner asserts that the priority date for the present application does not benefit from 10/172,492.

Applicants acknowledge the Examiner’s assertion with respect to the claims as presented, yet maintain the application’s claims of priority as originally presented.

CLAIM REJECTIONS – 35 USC 112

In the Office Action of May 19, 2010, the Examiner rejected claims 15 and 17 under 35 U.S.C 112, second paragraph, as failing to provide sufficient antecedent basis for limitations in these claims.

Applicants respectfully submit that this rejection is rendered moot by the amendments to claims 15 and 17 herein. Specifically, claim 15 has been amended to recite “a price” and claim 17 has been amended to depend from claim 16 instead of claim 14, whereby claim 16 provides antecedent basis for “the profile information” in claim 17.

CLAIM REJECTIONS – 35 USC 102

In the Office Action of May 19, 2010, the Examiner rejected claims 14, 15 and 19 under 35 U.S.C. 102(e) as being anticipated by Gupta (US 6,487,538).

This rejection is respectfully traversed, as Gupta fails to disclose or suggest each and every limitation of independent claim 14. Examiner asserts that Gupta discloses providing a page specific invitation to advertise link on a web page associated with its identifying universal resource identifier (URI). However, applicants find no such link disclosed in Gupta, either in the

sections cited by the Examiner or elsewhere. Gupta discloses transmission of a web page which “may include a determination regarding whether to insert a global advertisement or to transmit a blank advertisement slot for an advertisement insert by proxy 402.” (Gupta at 12:59-62) “Transmission by web server 404 may exclude a global advertisement or provide a replaceable advertisement block due to the lack of an advertising contract (with an advertiser), as a result of a previously agreed upon blank slot for the proxy to insert an advertisement, or as the result of a contract dynamically negotiated in real time between proxy 402 and web server 404.” (Gupta at 13:6-12) However, there is no disclosure of a link (a page specific invitation to advertise **link**) in or related to the advertisement slot.

Even assuming *arguendo* that the empty advertisement slot is considered a link, there is no disclosure of receiving a request to advertise **via the link** at an ad server, as required by the claim. Gupta’s proxy servers may insert an advertisement into the advertisement slot, however, it is not seen where a proxy server makes a request via a link.

Therefore, Gupta fails to disclose the claimed steps of providing a page specific invitation to advertise link on a web page associated with its identifying URI; and receiving a request to advertise via the link at an ad server. Since Gupta does not disclose each and every limitation of independent claim 14, Gupta does not anticipate independent claim 14. Should the Examiner remain unconvinced, applicants respectfully request the Examiner expressly identify what element in Gupta is considered the page specific invitation to advertise **link** and what is the request made via the link.

Dependent claims 15 and 19 include all of the limitations of independent claim 14 by virtue of their dependency thereon. Therefore, Gupta does not anticipate claim 15 or claim 19.

CLAIM REJECTIONS – 35 USC 103

In the Office Action of May 19, 2010, the Examiner rejected claims 16-18 and 20 under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of Gerace (US 5,848,396).

This rejection is respectfully traversed. Claims 16-18 and 20 are dependent on claim 14. As described above, Gupta fails to disclose or suggest each and every limitation of independent claim 14. Gerace fails to remedy the deficiencies of Gupta. Specifically, Gerace does not

disclose providing a page specific invitation to advertise link on a web page associated with its identifying URI; and receiving a request to advertise via the link at an ad server. Since neither reference, taken alone or in combination, provides sufficient disclosure to teach or suggest each and every limitation of the independent claim, the dependent claims too are patentable over these references.

NEW CLAIMS

Newly added claims 21-33 include new independent claims 22 and 28. Support for the subject matter in claims 21-33 is found, for example, in Figures 45-46 and at paragraphs [0200] through [0207] of the specification. Neither Gupta nor Gerace nor any of the prior art on record provides sufficient disclosure to teach or suggest each and every limitation of new independent claims 22 and 28.

New independent claim 22 requires the steps of displaying on the web page a page specific invitation to advertise on the web page, the page specific invitation to advertise including a link for submission of a request to advertise, the link including information identifying a universal resource identifier (URI) of the web page; and receiving a request to advertise on the web page via selection of the link by a requesting advertiser. Gupta does not disclose **displaying** an invitation to advertise on the page. Gupta's ad insertion into slots is automatic, transacted between the web server and one or more proxy servers as the page passes from the web server through the one or more proxy servers on the way to the client. Nowhere does Gupta disclose display of an invitation to advertise on a web page, whereby an advertiser requests to advertise on the web page by selecting a link. None of the prior art on record provides disclosure or suggestion of such display.

New independent claim 28 requires the steps of providing a page specific invitation to advertise link on a web page associated with its identifying universal resource identifier (URI), wherein the page specific invitation to advertise link comprises means for directing an individual to a different web resource; and receiving a request to advertise via the link at an ad server. Gupta does not disclose a link (a page specific invitation to advertise **link**) in or related to the advertisement slot, let alone a link comprising means for directing an individual to a different

web resource. Gupta's ad insertion into slots is automatic, transacted between the web server and one or more proxy servers as the page passes from the web server through the one or more proxy servers on the way to the client. Nowhere does Gupta disclose a link directing an individual to a different web resource, whereby an advertiser requests to advertise on the web page via the link. None of the prior art on record provides disclosure or suggestion of such a link.

Newly added dependent claims 21, 24 and 30 each require the additional step of notifying an advertiser that has been displaced from the advertisement space that the advertisement space is available at a higher price. None of the prior art on record provides disclosure or suggestion of this additional limitation.

SUMMARY

Examination and allowance of claims 14-33 is respectfully requested in light of the remarks herein. Applicants believe that entry of this amendment will place the present application in condition for allowance. In view of foregoing remarks, favorable consideration and early passage to issue of the present application is respectfully requested.

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Respectfully submitted,

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